

REMARKS

As may be appreciated from the listing of claims provided above, the claims have been amended herein. Support for the amendment of the claims may at least be appreciated from Figure 3 and paragraphs 30, and 37-39 of the specification. These paragraphs are the paragraph numbers from the published patent application for this application, which is U.S. Patent Application Publication No. 2006/0195526. **The paragraph numbers from U.S. Patent Application Publication No. 2006/0195526 are cited herein when citing to the Specification because it is believed that citation to these paragraph numbers makes it is easier for the Examiner to find the cited portions of the Specification.**

No additional fees are believed to be required for the present Amendment. Nevertheless, Authorization is provided herewith to pay any underpayment of fees or credit any overpayment of fees to Deposit Account No. 02-4800.

I. RESPONSE TO THE REJECTION OF CLAIMS 18-31 UNDER 35 U.S.C. § 112

Claims 18-31 were rejected under 35 U.S.C. § 112, first paragraph as not being supported in the specification sufficiently to comply with the written description requirement in the Office Action dated July 29, 2010 (hereafter "Office Action"). (Office Action, at 2). The Examiner contends that the limitation that "a message link insertion unit configured to insert a message link in the file of the file system when the user input requires the file attachment to be saved and linked . . ." is not supported in the specification. (Office Action, at 2).

The Examiner is directed to Figures 3 and 4 and paragraphs 30, 32-35, and 37-39. At Figure 4, a message link insertion unit is shown as link insertion unit 4A. (¶ 39). The link insertion unit 4A is for inserting at the selected memory location in the user file system 3, a

message link or backlink which refers back to an electronic message with a replaced file attachment." (¶ 39).

The system shown in Figure 4 is used to implement the method discussed in the Specification, which includes the description in paragraph 30. (¶ 37). For instance, paragraph 30 states that a system may be configured to utilize a method that executes a save as and link command. Such a command may have a file attachment saved and also create a message link "in the form of what is called a 'backlink' to the modified message," which is a backlink that refers to the electronic message that contained the saved file attachment. (¶ 33; Fig. 3). The backlink referring to this message along with the attachment that is saved are saved in the same user selected memory location in the user file system. (¶ 30, 32-35; Figure 3). For instance, both the backlink for the message and the attachment may be saved in the same file at the same time via actuation of the save as and link command. (¶ 30, 32-35; Figure 3). The attachment insertion unit 4 is configured to provide the insertion and saving of the backlinks for the attachments. (¶ 37-39). The link insertion unit 4A may be configured to provide the insertion and saving of the backlinks for the messages. (¶ 37 and 39).

In view of the above, there is clear support in the specification for the message link insertion unit limitation.

1. An Interview Is Requested With The Examiner

To the extent the Examiner disagrees with Applicants regarding the above discussed support for the limitations of claims 18 and 31, the Examiner is requested to call the undersigned to discuss these claim limitations. In the event the above description is not helpful to the Examiner, Applicants believe that a telephone conversation may help better explain where the

support for these limitations are and better identify to the Examiner the location of the support for the at-issue limitation in claims 18 and 31. The Examiner may call the undersigned at 412-392-2121 to schedule such an interview.

**II. RESPONSE TO THE REJECTION OF CLAIMS ISSUED
UNDER 35 U.S.C. § 103 IN THE OFFICE ACTION**

Claims 12-31 were rejected in the Office Action under 35 U.S.C. § 103 in view of Microsoft Outlook 2002, the Windows XP OS system of October of 2001 and U.S. Patent Application Publication No. 2004/0158607 to Coppinger et al. (Office Action, at 3).

A. Burden Of Proving Obviousness Under 35 U.S.C. § 103

"All words in a claim must be considered in judging the patentability of that claim against the prior art." MPEP § 2143.03 (emphasis added). "When evaluating claims for obviousness under 35 U.S.C. 103, all the limitations of the claims must be considered and given weight." MPEP § 2143.03. "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." *Id.* "A 35 U.S.C. 103 rejection is based on 35 U.S.C. 102(a), 102(b), 102(e), etc. depending on the type of prior art reference used and its publication or issue date." MPEP § 2141.01.

To establish a *prima facie* case of obviousness, an Examiner must show that an invention would have been obvious to a person of ordinary skill in the art at the time of the invention. MPEP § 2141. "Obviousness is a question of law based on underlying factual inquiries." *Id.* The factual inquiries enunciated by the Court include "ascertaining the differences between the claimed invention and the prior art" and "resolving the level of ordinary skill in the pertinent art." MPEP § 2141.

"A statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art at the time the claimed invention was made' because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references." MPEP § 2143.01. "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, **there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.**" MPEP § 2143.01 (citing *KSR*, 82 USPQ2d at 1396) (emphasis added).

Moreover, "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." MPEP § 2143.01. Also, "the proposed modification cannot render the prior art unsatisfactory for its intended purpose." MPEP § 2143.01.

B. Claims 12-17 And 23-26 Are Allowable

Currently pending claim 12 requires a method for processing an electronic message to include opening an electronic message, saving at least one file attachment of the electronic message in a user-selected memory location, replacing the at least one file attachment in the electronic message with at least one first link when the at least one file attachment is saved via actuation of a save as and link command, creating a second link to the electronic message when the at least one file attachment is saved via actuation of a save as and link command, and saving the second link in the user-selected memory location where the file attachment is also stored when the at least one file attachment is saved via actuation of a save as and link command. The

first link is configured to display the at least one file attachment after the at least one first link is actuated. The second link is configured to display the electronic message after that second link is actuated. Claims 13-17 and 23-26 depend directly or indirectly from claim 12 and therefore also contain these limitations.

**1. The Cited Art Does Not Teach Or Suggest
The Creation Of A Link To An Electronic Message And Saving Of
That Link In A File In Which A File Attachment Is Saved When
That File Attachment Is Saved**

The Examiner has cited Microsoft Outlook 2002 and Windows XP as teaching and suggesting saving a link to an electronic message where an attachment file may be saved. (Office Action, at 3). However, the cited art does not teach or suggest all the limitations of the pending claims

Microsoft Outlook 2002 and XP do not teach or suggest any saving of an attachment and also creating a link to the electronic message that initially has such an attachment when the attachment is saved. For example, there is no "save as and link" command or functionality provided by Outlook 2002 and XP as noted in paragraphs 24-35 of the specification.

As may be appreciated from the screen shots of Figures 1-13 provided by the Examiner in the Office Action, a user must manually save an email to a desktop, then create a short cut link, then save the short cut link in the file in which an attachment is stored to be able to even save such a short cut in that file location by using Outlook 2002 and XP. There is no saving of an attachment while also creating and saving a link to the electronic message in the same file the attachment is saved in that occurs when the attachment is saved.

Further, Coppinger et al. do not teach or suggest any message links or other links that refer to an electronic message nor the saving of such links in a file or other location in which an

attachment from that electronic message is saved. In fact, the Examiner has correctly recognized that the Coppinger et al. reference only deals with attachments of electronic messages. (Office Action, at 4).

The cited art fails to teach or suggest all the limitations of claims 12-31. These claims are allowable over the cited art.

**2. The Examiner Has Failed To Show That
XP And Outlook Utilize The Claimed Method**

Further, the Examiner has failed to show that the claimed method has actually ever been used. The Examiner has argued that Microsoft XP and Outlook 2002 provide functionality that could permit the method to be practiced. However, none of the cited art teaches or suggests that such functionality be used. This is particularly true when there are so many steps required for a user to actually perform such a method using XP and Outlook.

The Examiner has not provided any evidence showing that the method of claims 12-17 and 23-26 has been taught or is used in the prior art. For example, no reference or other art relied on by the Examiner shows that the steps shown in Figures 1-12 in the Office Action were ever practiced in the prior art. The Examiner's rejection merely argues that such functionality *could* permit a user to practice the method of the previously presented claim 12.

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981); MPEP § 2112.

Applicants understand the Examiner to argue that XP and Outlook inherently disclose the method of creating a link to an electronic message and saving that link in the same file as a file attachment of the electronic message is saved. However, "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999); MPEP 2112. At best, the Examiner has merely showed that a certain thing may result, not that is has resulted or was ever practiced. As found by the Federal Circuit in *In re Robertson*, and as stated in § 2112 of the MPEP, such evidence is insufficient to reject the pending claims.

For at least the above reasons, claims 12-17 and 23-26 are allowable over the cited art.

3. Claims 12-17 And 23-26 Include A Saved As And Link Command Limitation

In the Office Action, the Examiner asserted that no "saved as and link" command was required by the pending claims. (Office Action, at 8). As suggested by the Examiner in the Office Action, claim 12 has been amended to make clear that such a command is within the scope of the claims. (*Id.*). As noted above, none of the cited art teach or suggest the "saved as and link" functionality required in claims 12-17.

C. Claims 18-22 And 27-30 Are Allowable Over The Cited Art

Claim 18 is directed to a device that includes an attachment substitution unit that replaces a file attachment of a received electronic message with a memory location link after user input is received that requires the file attachment to be saved and linked via actuation of a save as and

link command. The device also includes a message link insertion unit that inserts a message link in a selected memory location when the file attachment is stored in the memory location in which the file attached to the electronic message is stored after the user input that requires the file attachment to be saved and linked via actuation of the save as and link command is received. The message link refers to the electronic message. Claims 19-22 and 27-29 depend directly or indirectly from claim 18 and, therefore, also contain this limitation.

Claims 18-22 and 27-30 were rejected as obvious in view of Microsoft Outlook 2002, the Windows XP OS system of October of 2001 and Coppinger et al. (Office Action, at 6).

As noted above with reference to claim 8, the cited art fails to teach or suggest any user input that requires a file attachment to be saved and linked and also requires units to insert a message link in a selected memory location when that user input is received and a fie attachment is saved in the memory location.

Microsoft Outlook 2002 and XP do not teach or suggest any saving of an attachment and also creating a link to the electronic message that initially has such an attachment when the attachment is saved. For example, there is no "save as and link" user input, command or functionality provided by Outlook 2002 and XP as noted in paragraphs 24-29 of the specification.

As may be appreciated from the screen shots of Figures 1-13 previously provided by the Examiner and referred to in the Office Action, a user must manually save an email to a desktop, then create a short cut link, then save the short cut link in the file in which an attachment is stored to be able to even save such a short cut in that file location by using Outlook 2002 and

XP. There is no saving of an attachment while also creating and saving a link to the electronic message in the same file attachment that occurs when the attachment is saved.

Further, Coppinger et al. do not teach or suggest any message links or other links that refer to an electronic message nor the saving of such links in a file or other location in which an attachment from that electronic message is saved. In fact, the Examiner has correctly recognized that Coppinger et al. only deals with attachments of electronic messages. (Office Action, at 4).

For at least the above reasons, the cited art do not teach or suggest each and every limitation of claims 18-22 and 27-30. Therefore, the cited combination of art cannot render these claims obvious

**1. Claims 18-22 And 27-30 Now Include A Saved As
And Link Command Limitation**

In the Office Action, the Examiner asserted that no "saved as and link" command was required by the pending claims. (Office Action, at 8). As suggested by the Examiner in the Office Action, claim 12 has been amended to make clear that such a command is within the scope of the claims. (*Id.*). As noted above, none of the cited art teach or suggest the "saved as and link" functionality required in claims 12-17.

D. Claim 31 Is Allowable Over The Cited Art

Claim 31 is an independent claim and requires a device to include an attachment substitution unit that replaces a file attachment of a received electronic message with a memory location link when user input provides a save as and link command requiring the file attachment to be saved and linked in the file. The device also includes a message link insertion unit that inserts a message link in the file of the file system when the user input requires the file attachment to be saved and linked. The message link refers to the electronic message such that

the message is displayed after the message link is actuated. The device also includes a control unit that controls the attachment substitution unit and message link insertion unit so that attachment substitution and message link insertion occurs automatically when the user input requiring the file attachment to be saved and linked is provided to the device.

The cited art does not teach or suggest any attachment substitution unit configured to replace the file attachment of any received electronic message. As noted above, the cited art does not teach or suggest any message link insertion unit that inserts a message link in a file that also has a file attachment of that message stored therein when user input requires the file attachment to be saved and linked. In fact, none of the cited art teaches or suggests any device to act on user input that requires both saving of an attachment and linking to occur.

**E. Granted European Patent No. EP 1 642 229
Shows The Pending Claims Are Allowable**

The present application corresponds to granted European Patent No. EP 1 642 229B1. For the Examiner's reference, a copy of this patent was provided to the Examiner with the Amendment dated May 13, 2009. The European Patent Office has found the invention disclosed in the present application to warrant patent protection and includes claims that are similar in scope to those pending in the present U.S. patent application. This is an indicia of the non-obvious nature of the pending claims and shows that the claims should be allowed.

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III. CONCLUSION

For at least the above reasons, reconsideration and allowance of all pending claims are respectfully requested.

Respectfully submitted,

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